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| 09/986,476      | 11/08/2001  | Keisuke Tanaka       | 2091-0247P          | 5608             |

7590 06/15/2007  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
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Falls Church, VA 22040-0747

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| EXAMINER |
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MILIA, MARK R

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| ART UNIT | PAPER NUMBER |
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2625

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06/15/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/986,476

Applicant(s)

TANAKA, KEISUKE

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4,5,7-9,11,12,14-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-9,11,12,14-16 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 3/16/07 and has been entered and made of record. Currently, claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, and 18-22 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 8, 15, and 22 have been considered but are moot in view of the current amendment to the claims and therefore new ground(s) of rejection will be made.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 2, 4-5, 7-9, 11-12, 14-16, 18-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US 6657702) in view of Fredlund (US 6154295) and further in view of well known prior art.

Regarding claim 1, Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see

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Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly wherein the server is adapted to perform setting a predetermined storage period of the image data and displaying the predetermined storage period on the user terminal.

Fredlund discloses wherein the server is adapted to perform setting a predetermined storage period of the image data (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states

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that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 1.

Regarding claim 8, Chui discloses a print ordering system comprising a server adapted to receive an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), wherein the server is adapted to store the image data transferred thereto regardless of whether or not the order is placed at the time of transfer of the image data, and receives the order for the print regarding the image data stored therein after the image data are stored therein in the case where the order was not placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65, column 12 lines 39-51, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47), and wherein the server is further adapted to display on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly wherein the server sets a predetermined storage period of the image data and to display the predetermined storage period on the user terminal.

Fredlund discloses wherein the server sets a predetermined storage period of the image data (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo

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processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 8.

Regarding claim 15, Chui discloses a computer-readable recording medium storing a program to cause a computer to execute a print ordering method used in a print ordering system, the print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the program comprising the procedures of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Figs. 3A and 5, column 10 lines 41-65 and column 12 lines 39-51) and receiving the order for the print of the image data stored in the server after the image data are stored in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52), and displaying on the user terminal a list of the image data stored in the server at the time the order for the print is placed if the order is not placed at the time the image data are transferred (see Fig. 5, column 13 line 66-column 14 line 8, column 14 lines 47-52, and column 15 lines 31-47).

Chui does not disclose expressly the program causing the server to perform setting a predetermined storage period of the image data and displaying the predetermined storage period on the user terminal.

Fredlund discloses wherein the server is adapted to perform setting a predetermined storage period of the image data (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo



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processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted).

Chui and Fredlund also do not disclose expressly displaying the predetermined storage period on the user terminal. However, it is well known in the art (Official Notice) to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location (server) and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the calling of a 1-800 number to extend a storage period with the extending of the storage period through the interface/web page of the photo processing location.

Therefore it would have been obvious to modify the server of Chui to set the predetermined storage period, such as Fredlund discloses, and display said storage period on the user terminal because Chui discloses a display that allows a user to set a plurality of options for selecting and printing digital files and it would provide a user with greater control over the transmitted images, especially the period of time in which the image will be available to the user, which would provide the user with more time to decide when, and if, the user desires the digital images to be printed.

Chui & Fredlund are combinable because they are from the same field of endeavor, storage and ordering of digital prints.

Therefore, it would have been obvious to combine well known prior art and Fredlund with Chui to obtain the invention as specified in claims 15.

Regarding claims 2, 9, and 16, Chui further discloses accepting and storing image data (see column 10 lines 41-65, column 12 lines 39-51, column 13 line 66- column 14 line 8 and column 14 lines 47-52) and Enomoto further discloses accepting and storing the image data at the time the order is received if the order is placed at the time the image data are transferred (see abstract, column 3 lines 45-48 and 61-63, column 4 lines 61-65, column 6 lines 23-54, and column 7 lines 15-22, reference shows that the order data and image data are transmitted at the same time to the photo-finisher for output and delivery of prints).

Regarding claims 4, 11, and 18, Fredlund further discloses deleting the image data from the server after the predetermined storage period has elapsed since the image data were put into storage (see column 3 lines 41-54 and column 4 lines 43-47).

Regarding claims 5, 12, and 19, Fredlund further discloses extending the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or

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extend the storage period that the digital files are automatically deleted and that ordering a service may also extend the storage period of the digital files).

Regarding claims 7, 14, and 21, Chui further discloses if the order for the print of the image data is an order for a postcard which has seasonality (see column 4 lines 13-22 and column 23 lines 9-23) and Fredlund further discloses setting the predetermined storage period of the image data to a period corresponding to a content of a postcard (see column 3 lines 41-54 and column 4 lines 43-47, reference states that the user inputs option data, of which storage time designation is a part of, the storage time can be any amount of time the user desires).

5. Claims 20 and 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chui (US 6657702) in view of Fredlund (US 6154295) and U.S. Patent No. 6556817 to Souissi et al.

Chui discloses a print ordering method used in a print ordering system comprising a server for receiving an order for a print of image data (see Fig. 3A and column 10 lines 41-59) and a user terminal which is connected to the server via a network and used for placing the order for the print of the image data (see Fig. 3A and column 10 lines 56-65), the print ordering method comprising the steps of: accepting transfer of the image data to the server and storing the image data in the server regardless of whether or not the order is placed at the time of the transfer of the image data (see Fig. 3A, column 10 lines 41-65 and column 12 lines 39-51), and receiving the order for the print of the image data stored in the server after the image data are stored

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in the server in the case where the order was not placed at the time of the transfer of the image data (see column 13 line 66-column 14 line 8 and column 14 lines 47-52).

Chui does not disclose expressly determining a time of day when communications costs are lower than at other times of day, performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower, writing a predetermined storage period of the image data in tag information of the image data, and the server performing extending the predetermined storage period of the image data for which the order was placed.

Fredlund discloses writing a predetermined storage period of the image data in tag information of the image data and the server performing extending the predetermined storage period for the image data for which the order was placed (see Fig. 1, column 3 lines 28-32 and 41-57, and column 4 lines 39-51, reference states that a customer can call the photo processing lab and have the storage period for the digital file associated with their negatives extended for a certain period of time, which implies that an initial storage period is automatically set by the photo processing lab, and the reference also states that after a certain period of time, if the customer does not order or extend the storage period that the digital files are automatically deleted and that ordering a service may also extend the storage period of the digital files).

Souissi discloses determining a time of day when communications costs are lower than at other times of day and performing transfer of the image data from the user terminal to the server during the time of day when communications costs are lower (see column 5 lines 26-32 and column 6 lines 33-57).

Chui, Fredlund, & Souissi are combinable because they are from the same field of endeavor, transmission of data over a network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the writing and extending a storage period of the image data in tag information, as described by Fredlund, and the transferring of image data to a server when communications costs are low, as described by Souissi, and which is well known and commonly used, with the system of Chui.

The suggestion/motivation for doing so would have been to save money and be able to provide lost cost prints to a user by utilizing low cost communications and purging of image files after a certain period of time.

Therefore, it would have been obvious to combine Fredlund and Souissi with Chui to obtain the invention as specified in claim 22.

Regarding claim 20, Chui and Fredlund do not disclose expressly displaying the predetermined storage period on the user terminal. However, it would have been obvious to have the server of Chui display said storage period on the user terminal as Chui discloses a display which allows a user to set a plurality of options for selected and printing digital files and it is well known in the art to have a user interface which displays a web page or the like that links a customer to digital files located at a photo processing location and use the interface to select, modify, print, etc. digital files and therefore it would have been obvious to replace the call of a 1-800 number to extend a storage

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period with the extending of the storage period through the interface/web page of the photo processing location.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period; then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


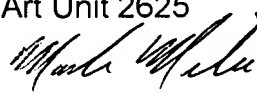
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

 Mark R. Milia  
Examiner  
Art Unit 2625  
  
**KING Y. POON**  
**PRIMARY EXAMINER**